

Remarks

The claims have been amended in view of the official action and to more particularly state what Applicant believes is his invention. In particular, dependant Claim 21 has been amended to claim an alloy powder according to Claim 1, wherein said alloy powder further comprises between 15 ppm and 175 ppm Zr based on total metal. Support for the foregoing amendment can be found at paragraph 0043 of the application as published.

35 U.S.C. §112 Rejection

The Examiner has rejected Claims 1-4, 14 and 18-21 on the grounds that they fail to comply with the written description requirement and therefore are not in conformance with 35 USC §112. In particular, the Examiner has stated that:

“Claim 1 as currently cast contains new matter because there is no support for a base metal alloy powder comprising at least from about 58% by weight Ni, about 0.2 to 30% by weight Cu and about 6 to 40% by weight Cr. While there is support for a base metal alloy powder comprising at least 58% by weight Ni, about 6% to 40% by weight Cr, Table 3; there is no support for the upper limit of Cu (to 30% by weight Cu) in the Table.”
[emphasis added]

Applicant traverses the rejection according to the following arguments. 35 USC §112 requires that “[t]he specification shall contain a written description of the invention ...”. In this regard, Applicant submits that “... the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Company v. Far-Mar-Co., Inc.*, 227 USPQ 177 (Fed. Cir.) at 179. It is perhaps trite law to say that the specification includes not only the text, tables and figures used in support of the text, but also the claims as originally filed.

Indeed, MPEP §2163 I. states: "... It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." Applicant points out that claim 6 as originally filed expressly claims an alloy powder which "...comprises from about 0,2 to 30% by weight of Copper," which is exactly the range of Copper currently being claimed. Furthermore, Applicant notes that this application claims priority to International Application No. PCT/CA02/01585, which is incorporated by reference in its entirety. As-filed claim 13 of this international application is a multiple dependent claims and includes all of the elements of rejected claim 1. Therefore it is absolutely apparent that the Applicant contemplated the use of the range being claimed and as a result "... had possession at that time of the later claimed subject matter".

The Examiner has further rejected dependant Claim 21 on the grounds that it contained new matter. Applicant submits that Claim 21 as amended overcomes this objection.

Reinstatement of Withdrawn Claims

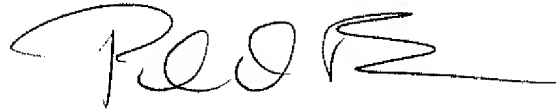
Applicants respectfully request reinstatement of withdrawn claims 8-11, 16, and 17. These claims depend from independent claim 1 which was indicated as being generic.

Conclusion

In the light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No fee is believed to be due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 7012-X04-002).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Bianco', with a long horizontal flourish extending to the right.

Paul Bianco, Reg. #43,500

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